

REMARKS

The present application was filed on August 18, 2000 with claims 1-23. The independent claims are 1, 11 and 20.

In the outstanding final Office Action dated September 27, 2004, the Examiner: (i) rejects claims 3 and 13 under 35 U.S.C. §101 as being inoperable; (ii) rejects claims 1, 4-9, 11 and 14-23 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,577,120 to Penzias (hereinafter "Penzias"); and (iii) rejects claims 2, 10 and 12 under 35 U.S.C. §103(a) as being unpatentable over Penzias in view of U.S. Patent No. 4,993,068 to Piosenka et al. (hereinafter "Piosenka").

In this response, Applicants continue to traverse the §101, §102(b) and §103(a) rejections, and request reconsideration of the present application in view of the following remarks.

With respect to the §101 rejection of claims 3 and 13, Applicants note that these claims describe a method and an apparatus "wherein the one or more identifiers are assigned to the one or more users before the data units are entered by the one or more users." In formulating the §101 rejection of these claims, the Examiner argues on p. 3 of the Office Action:

Claims 3, 13 are rejected under 35 U.S.C. §101 because the disclosed invention is inoperative and therefore lacks utility. How can identifiers being (*sic*) assigned to a user before the user enters data or establishes an association with the computing device? The user would be unknown to the device at this point and assigning and (*sic*) identifier to this user would not be possible.

Applicants respectfully disagree. One skilled in the art would recognize that a method or apparatus could operate in accordance with claims 3 and 13 if, for example, a party other than the one or more users utilizing the collaborative computing system were to assign the identifiers. Such a third party could, for example, be a system administrator for the collaborative computing system. In accordance with the claims, by way of one example, the system administrator could assign the identifiers to the one or more users before data units are entered by the one or more users. Based on this scenario, as well as several others, claims 3 and 13 are clearly operable. Applicants, therefore, respectfully request withdrawal of the §101 rejection.

With respect to the §102(b) rejections, Applicants initially note that the Manual of Patent Examining Procedure (MPEP), Eighth Edition, August 2001, §2131, specifies that a given claim is anticipated “only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference,” citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, MPEP §2131 indicates that the cited reference must show the “identical invention . . . in as complete detail as is contained in the . . . claim,” citing Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Independent claims 1, 11 and 20 describe methods and apparatus “for use in a distributed collaborative computing system with two or more collaborative computing devices coupled via a communication network and respectively executing a collaborative application thereon.” The Examiner, in formulating the §102(b) rejection for the independent claims, argues that each and every one of the limitations of these claims is anticipated by Penzias. More specifically, the Examiner states:

In this case, Penzias discloses a method for retail transaction identification wherein a purchaser is required to provide identification along with biometric information, at a point of sale terminal, in the form of either height, weight, eye/hair color, fingerprint, iris image, or voice print in order to purchase a certain product. At the time of purchase, the purchaser’s identification information, biometric information, and information about the transaction itself (data unit) is stored, which meets the limitation of associating one or more identifiers with data units respectively entered by one or more users at at least one of the two or more collaborative computing devices so that data entered by one or more is uniquely identifiable in the distributed collaborative computing system. The stored information is recoverable upon authorization by a central maintenance agency (Col. 2, line 37 - Col. 3, line 52), which meets the limitation of storing the data units and the one or more associated unique identifiers, the stored data units and associate (*sic*) unique identifier being accessible to the two or more collaborative computing devices in the distributed collaborative computing system in accordance with the collaborative application. (Office Action, p. 2-3).

Applicants respectfully disagree. One difference between the claims and the reference is that the claims relate to a “distributed collaborative computing system” such as “a collaborative

whiteboard system” (Specification, p. 3, lines 2-4), while the reference relates to a system for identifying individuals who have engaged in a retail transaction. One of ordinary skill in the art will recognize that these systems perform different functions and are, therefore, not identical. To collaborate means, by way of example, to work together with others, especially in an intellectual endeavor (*Merriam-Webster Dictionary*, 1996). Correspondingly, a “distributed collaborative computing system” must necessarily function to allow users at different locations to work together for some joint purpose.

For instance, in a collaborative whiteboard system in accordance with this invention, a user at a first location is able to view information written by a user at a second location. This way, the remote users may interact as if they are in the same location (Specification, p. 2, lines 7-10).

The computing system of Penzias, on the other hand, functions only to identify a user and clearly lacks any purpose in facilitating collaboration between users. In fact, according to the reference, the users of the reference’s “retail transaction identification” system consist of individuals who have “engaged in a commercial, retail or other transaction” (Penzias, col 1, lines 9-12) and government agencies trying to retroactively find these individuals, primarily as part of criminal investigations (Penzias, col. 1, lines 11-12, col. 3, line 63 - col. 4, line 10). Based on the identities of these users, Applicants respectfully submit that it would be unreasonable to assert that the individuals (potentially criminals and terrorists) using the reference’s “retail transaction identification” system are in some way working together with government agencies who are potentially trying to search them out. As a result, the reference’s system does not teach a “distributed collaborative computing system.”

The Examiner further argues with respect to the §102(b) rejection, that “the use of smart cards and point of sale terminals to authenticate users (Col. 5, line 1 - Col. 6, line 57), . . . would meet the limitation of a collaborative computing system because they ‘work together’ to authenticate the users” (Office Action, p. 2). Applicants, again, respectfully disagree. As stated above, a collaborative computing system is defined by the present invention to be one which allows individuals at different locations to work together for some joint purpose. These users could, for example, comprise engineers at disparate locations conducting a discourse on a technical issue

(Specification, p. 6, lines 13-16). Accordingly, the collaborative computer system is not, as the Examiner seems to argue, merely a system wherein two or more electronic devices share digital data.

Based at least on these deficiencies, Applicants submit that Penzias fails to describe each and every element of claim 1, 11 and 20 and, therefore, does not anticipate these claims under §102(b).

With respect to the §102(b) rejection of dependent claims 4-6, 8, 9, 14-16, 18, 19 and 21-23, Applicants initially note that the Examiner, in formulating the §102(b) rejection of these claims, provides no specific arguments as to why these claims are anticipated by Penzias beyond that provided for their respective independent claims. In other words, the Examiner does not cite the specific portions of Penzias that allegedly anticipate the particular limitations of these dependent claims. Applicants respectfully submit that this does not meet the specificity requirements for a rejection under MPEP §706. MPEP §706 requires that “[w]hen a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable.” The rejection of these dependent claims is, therefore, improper.

Despite this defect, Applicants submit that dependent claims 4-9, 14-19 and 21-23 are allowable for at least the reasons stated above with respect to their respective independent claims. Moreover, Applicants also assert that these dependent claims contain separately patentable subject matter. For example, dependent claims 21 and 22 include limitations wherein the apparatus of independent claim 20 includes “a user settable switch” and “a personal area network system.” Applicants submit that Penzias fails entirely to describe such a “switch” or “network.” In fact, Penzias does not contain the words “switch” and “network.”

With respect to the §103(a) rejection of dependent claims 2, 10 and 12 with reference to Penzias in view of Piosenka, Applicants respectfully submit that the Piosenka reference fails to supplement the above-described fundamental deficiencies of Penzias as applied to independent claims 1 and 11. These dependent claims would, as a result, not have been obvious at the time that the invention was made.

Furthermore, Applicants continue to respectfully submit that the Examiner’s stated motivation for combining the Penzias and Piosenka references is inadequate under the MPEP and

recent case law from the Federal Circuit. In formulating the §103(a) rejection to claims 2, 10 and 12, the Examiner states:

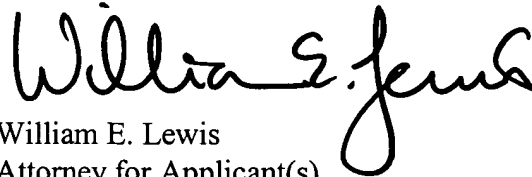
Penzias does not disclose that the point of sale terminals accepts signature biometric information. Piosenka discloses a personal identification system wherein the biometric terminal accepts signatures via a pressure sensitive tablet (Col. 5, lines 20-27, Fig. 1) (whiteboard system). It would have been obvious to one of ordinary skill in the art at the time the invention was made to authenticate the purchasers of Penzias using dynamic signature via pressure sensitive tablets in order to provide universally accepted personal identification information as taught by Piosenka (Col. 2, lines 43-48). (Office Action, pp. 2-3).

The Federal Circuit has stated that when patentability turns on the questions of obviousness, the obviousness determination “must be based on objective evidence of record” and that “this precedent has been reinforced in myriad decisions, and cannot be dispensed with.” In re Sang-Su Lee, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Moreover, the Federal Circuit has stated that “conclusory statements” by an examiner fail to adequately address the factual questions of motivation, which is material to patentability and cannot be resolved “on subjective belief and unknown authority.” Id. at 1343-1344. Applicants respectfully submit that this §103(a) rejection contains no such showing of objective evidence of record that would motivate one skilled in the art to combine the proposed references as suggested by the Examiner. Instead the above quoted language is precisely the type of subjective, conclusory statements that the Federal Circuit has indicated provides insufficient support for an obviousness rejection.

In view of the above, Applicants believe that claims 1-23 are in condition for allowance, and respectfully request the withdrawal of the §101, §102(b) and §103(a) rejections.

Applicants file a Notice of Appeal concurrent with this Response.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "William E. Lewis". The signature is fluid and cursive, with the first name "William" being the most prominent part.

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